



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,622	01/25/2002	Toshihiro Morita	450101-02902	3915
20999	7590	03/22/2004	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			COBY, FRANTZ	
			ART UNIT	PAPER NUMBER
			2171	9

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/913,622	MORITA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frantz Coby	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 29 December 2003.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 5 and 7 is/are rejected.
- 7) Claim(s) 4, 6 and 8 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

This is in response to applicant's amendment filed on December 29, 2003 in which claims 1-8 were amended.

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. Therefore, the rejection of claims 1-3, 5 and 7 under section 102(e) paper # 7, mailed September 26, 2003 remains.

**Status of Claims**

Claims 1-8 are pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "as the other types of data" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "as the other types of data" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 2-3, the language "the other types of data" renders the claims indefinite because it is unclear as to which other types of data is being claimed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim1-3, 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Weisberg U.S. Patent no. 6,351,736.

As per claim 1, Weisberg et al. disclose an information processor comprising "a first recording means for recording a predetermined number of types of data related to a first content as a first main data group" (See Weisberg et al. Col. 5, lines 12-41, col.)-, "a second recording means for recording data of types related to the first content but not in the first main data group as a sub data group" (See Weisberg et al. Col. 6, lines

10-27). In addition, Weisberg et al. disclose the claimed feature of "the first recording means relating a predetermined number of types of data about the second content as a second main data group with the second content and record the data, and the second recording means relating data of types other than the second main data group about the second content with the second content and recording the data in the sub data group" (See Weisberg et al. Col. 1, line 65-Col. 2, line 64).

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Weisberg et al. disclose the claimed feature of "wherein the second recording means records a usage rule for the first and second contents as the other types of data" as an advertisement module for receiving advertisement of the second data type and for driving the user computer to display the advertisement (See Weisberg et al. Col. 2, lines 36-41).

As per claim 3, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Weisberg et al. disclose the claimed feature of "wherein the second recording means records, as the other types of data, data used to control a device using the first and second contents" (See Weisberg et al. Col. 1, line 65-Col. 2, line 64).

As per claim 5, all the limitations of these claims have been noted in the rejection of claims 1. It is therefore rejected as set forth above.

As per claim 7, all the limitations of these claims have been noted in the rejection of claims 1. It is therefore rejected as set forth above.

**Remarks**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Weisberg fails to teach or suggest having at least two recording means for recording types of data related to at least two different contents such that a predetermined number of content related data can be recorded as a sub data group without changing the configuration of the main data group) are not recited in the rejected claim(s); especially, the feature of "recorded as a sub data group without changing the configuration of the main data group". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**Allowable Subject Matter**

Claims 4, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fail to show the claimed features of "means for determining, when reading data about a content, whether a type of data to be read is that of data recorded in either the main data group or the sub data group; and means for searching for data from a plurality of main data groups of sub data groups based on the result of the data type definition".

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahić can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

*Frantz Coby*  
Frantz Coby  
Primary Examiner  
Art Unit 2171

March 20, 2004